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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,443	04/17/2001	Yoshinobu Shiraiwa	35.C15299	5474

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EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/835,443

Applicant(s)

SHIRAIWA, YOSHINOBU

Examiner

Dan Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,8-11 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,8-11 and 14-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20040123</u> + <u>20031002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 19-20 are objected to because of the following informalities:

In claims 19-20, applicant recites that the perforations are in a straight line. This limitation appears to conflict with respective parent claims 1 and 5. In claims 1 and 5, applicant recites that the two pairs of opposite sides are connected by four corners and also that the four corners of the center portion have a round shape. Respective parent claims 2 and 6 further limit the claim by adding perforations between the center portion and the outside portions. This would appear to be the embodiment shown in Figure 2 of applicant's drawings. Since the opposite sides are connected by the four corners of the center portion it does not appear that the perforations can be in a straight line since the corners are rounded.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4, 15, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod in view of Nakaya.

With respect to claim 1, McLeod discloses the claimed printing paper except for the round shape of the four corners. McLeod discloses a printing paper with a center portion 10a

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and two end portions 10b and 10c. The center portion has two pairs of opposite sides and four corners as shown in Figures 1, 5 and 6 of McLeod. Additionally, one pair of opposite sides of the central portion 10a have no other printing paper attached. Nakaya teaches a printed sheet 2 (therefore a printing paper) with a central portion 1. The four corners of the central portion 1 are rounded as shown in Figure 1 of Nakaya. It is noted that the right side of the central portion 1 is not attached to any other printing paper, thus it is known to create rounded corners at an edge of a printing paper. The selection of rounded corners over squared corners would have been an obvious variation to one of ordinary skill in the art which would be selected for the aesthetic design of the paper.

With respect to claim 2, McLeod discloses that the printing paper has perforations 12 and 14 between the center portion 10a and the outside portions 10b and 10c.

With respect to claim 4, the round corners taught by Nakaya are shaped as arcs as shown in Figure 1 of Nakaya.

With respect to claim 15, any size of printing paper would have been obvious to one of ordinary skill in the art since the size of the paper has no bearing on the above mentioned structure.

With respect to claim 17, McLeod discloses a printing paper where an image is not formed on the outside portions.

With respect to claim 19, to the extent that this claim can be understood, McLeod discloses perforations in a straight line.

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4. Claims 5-6, 8, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod in view of Skees and Nakamura.

With respect to claim 1, McLeod discloses the claimed printing paper except for the round shape of the four comers and that the paper is a label. McLeod discloses a printing paper with a center portion 10a and two end portions 10b and 10c. The center portion has two pairs of opposite sides and four corners as shown in Figure 1, 5 and 6 of McLeod. Additionally, one pair of opposite sides of the center portion 10a have no other printing paper attached.

Skees teaches a printed sheet 26 (therefore a printing paper) with an inner portion 36. The four corners of the portion 36 are rounded as shown in Figure 7 of Skees. It is noted that the bottom side of the inner portion 36 is not attached to any other label printing paper. thus it is known to create rounded corners at an edge of a label printing paper. The selection of rounded corners of Skees over squared corners disclosed by McLeod would have been an obvious variation to one of ordinary skill in the art which would be selected for the aesthetic design of the paper.

Nakamura teaches a card 74 that is a central portion of a larger sheet 72 as shown in figure 6 of Nakamura. Card 74 can be separated from a sheet 72 and applied as a label through the use of adhesive 76. It would have been obvious to combine the teaching of Nakamura with the printing paper disclosed by McLeod for the advantage of permanently fixing the printed card to another surface for decorative purposes or to another sheet of paper for informational purposes.

With respect to claim 6, McLeod discloses that the printing paper has perforations 12 and 14 between the center portion 10a and the outside portions 10b and 10c.

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With respect to claim 8, the round corners taught by Skees are shaped as arc as shown in Figure 7 of Skees.

With respect to claim 16, any size or printing paper would have been obvious to one of ordinary skill in the art since the size of the paper has no bearing on the above mentioned structure.

With respect to claim 18, McLeod discloses a printing paper where an image is not formed on the outside portions.

With respect to claim 20, to the extent that this claim can be understood, McLeod discloses perforations in a straight line.

5. Claims 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLeod in view of Skees and Nakamura, as applied to claims 1, 2 4 and 15 above, and further in view of Hirano et al.

With respect to claims 9 and 10, McLeod in view of Skees and Nakamura discloses a printing paper as mentioned above, but it is not known to the examiner what type of feeding device is used in the printer 4. However, Hirano et al. teaches that it is known to feed a label paper through a printer while holding the outside edges of a label media as shown in Figure 3 of Hirano et al. It would have been obvious to combine the teaching of Hirano et al. with the label printing paper disclosed by McLeod in view of Skees and Nakamura for the advantage of feeding the label media in both direction in order to maintain the correct tension in the media (see abstract of Hirano et al.). Additionally, it would have been obvious to print on label paper for the self-adhesive advantages of labels.

With respect to claims 11 and 14, Hirano et al. discloses a printing system including a printhead 24 and two rollers 17 and 18 which hold the entire label including the outside portions as shown in Figures 1 and 3 of Hirano et al.

Response to Arguments

6. Applicant's arguments filed 1/23/04 have been fully considered but they are not persuasive of any error in the above rejection.

It is noted that a portion of the amendment made to the independent claims carries not patentable weight in the claims. The phrase, "are removed from the center portion after an image is formed on the center portion" is a method of intended use. Since the claims are drawn towards apparatus claims the method of using the printing paper is not considered when determining patentability (see MPEP § 2114).

With respect to applicant's arguments regarding the combination of McLeod and Nakaya, McLeod is relied upon to disclose all the claimed features except for rounded perforations at the corners of the center portion. Nakaya is relied upon solely to teach a rounded perforations at the edge of the sheet. Both McLeod and Nakaya teach printing papers, thus one of ordinary skill in would have found the combination obvious.

With respect to applicant's arguments regarding size, it is noted that there is no mention of any particular size in the independent claims. Furthermore, while McLeod, Nakaya and Skees teach differently sized printing papers one of ordinary skill in the art certainly would recognize that perforations can be used in any type and/or size of paper for the advantage of easily removing undesirable portions of the paper.

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Applicant argues that McLeod, Nakaya and Skees have different reasons for creating their outside portions. This may be so, but one of ordinary skill in the art would still see the advantages or aesthetic value of the curved portions and would be able to apply that teaching to the printing paper disclosed by McLeod.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 3, 2004



Daniel G. Colilla
Primary Examiner
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